

APPLICANT(S): BIEBER, Avigdor et al.

SERIAL NO.: 10/519,478

FILED: December 30, 2004

Page 5

## **REMARKS**

Applicants respectfully request reconsideration of the above-identified application in view of the following remarks.

### **Status of Claims**

Claims 7, 13-23, and 27 were previously canceled. Accordingly, Claims 1-6, 8-12, and 24-26 remain pending in the application.

### **Claim Rejections**

#### **35 U.S.C. § 103 Rejections**

In paragraphs numbered 6 and 7 bridging pages 2-5 of the Office Action, the Examiner rejected Claims 1–6, 8-12, and 24–25 under 35 U.S.C. § 103(a), as being unpatentable over Teng (US 6,242,156) in view of Crawford et al. (US 4,430,366). In paragraph number 8 bridging pages 5 and 6 of the Office Action, the Examiner has further rejected Claims 1 and 26 as being unpatentable over Teng in view of Crawford et al. as evidenced by Nishida et al. (US 5,417,164).

Applicants respectfully assert that the combination of Teng, Crawford, and Nishida et al. does not teach or suggest "...wherein the concentration ratio of the metal to metal oxide within the laser-absorbing layer is higher than the concentration ratio of the metal to metal oxide at both edges of the laser-absorbing layer...". Rather, Crawford teaches to either have a concentration ratio of the metal to metal oxide within the laser-absorbing layer higher at the top of the absorbing layer than at the bottom, or to have a concentration ratio of the metal to metal oxide within the laser-absorbing layer higher at the bottom than at the top of the absorbing layer. Specifically, Crawford teaches in Column 3, lines 23-27:

"One can in fact deposit a layer comprising 100% metal  
at one surface (the top or bottom of the coating layer)  
and 100% metal oxide or sulfide at the other surface."

APPLICANT(S): BIEBER, Avigdor et al.

SERIAL NO.: 10/519,478

FILED: December 30, 2004

Page 6

Thus, the Crawford reference teaches to have a concentration ratio with a unidirectional gradient from the top to the bottom of the absorbing layer. A unidirectional gradient is directly opposite from the bidirectional gradient recited in Claim 1 which states that the concentration ratio of the metal to metal oxide within the laser-absorbing layer is higher than the concentration ratio of the metal to metal oxide at both edges of the laser-absorbing layer.

Further, Crawford teaches in Col. 3, lines 27-29 that:

“This kind of construction is a particularly desirable one because it provides a strong coherent coating layer with excellent adhesion to the substrate”

Such a construction having excellent adhesion would lead a person of skill in the art to understand that even more energy than what would otherwise be expected would be needed to detach the absorbing layer from the substrate.

In the paragraphs bridging pages 8 and 9 of the Office Action, the Examiner stated,

“As for more energy being required because of stronger adhesion, the adhesion is not related to the amount of energy needed to ablate the layers because the overcoat layer is insensitive to radiation and is removed during development.”

Yet, unlike the member disclosed by Teng, the printing member disclosed and claimed in the present application does not undergo a development process. Instead, the claimed laser absorbing layer is positioned between the substrate and the coating layer. For this reason, a person of skill in the art, reading Crawford would expect that more energy would be required to detach the excellent adhesion therein described. It is the object of Applicant's invention to have a printing member that is more efficient and therefore would require less energy to ablate than what would otherwise be expected.

The Examiner makes the further statement,

APPLICANT(S): BIEBER, Avigdor et al.

SERIAL NO.: 10/519,478

FILED: December 30, 2004

Page 7

"According to page 9, lines 6-11, it is the structure of the laser absorbing layer and not the amount of adhesion that may accelerate the imaging process and increase sensitivity."

However, this quote is from the disclosure of the Applicants and represent their discovery, which is contrary to the common understanding of a person of skill in the art reading the prior art. It is therefore inappropriate for the Examiner to rely on the unexpected discovery of the Applicants to obviate their own claim.

It is submitted that the Nishida et al reference fails to supply the deficiencies described above. It is therefore respectfully submitted that the additional teachings of either the Teng reference or the Nishida et al. reference cannot cure the deficiencies of the Crawford disclosure. Therefore, the disclosures of Teng and Crawford alone or in combination with the Nishida et al. reference do not render amended Claim 1 or the claims dependent therefrom obvious.

For the foregoing reasons, Applicants' invention is patentable over the cited art and Applicants respectfully request that the rejections of the claims under 35 U.S.C. § 103(a) be withdrawn. Such action is respectfully solicited.

### **Conclusion**

In view of the foregoing, Applicants submit that the pending claims clearly distinguish over the prior art of record and are in condition for allowance.

Favorable consideration and passage to issue of the present application is therefore respectfully requested.

The Examiner is invited to telephone the undersigned to discuss any still outstanding matters with respect to the present application.

APPLICANT(S): BIEBER, Avigdor et al.

SERIAL NO.: 10/519,478

FILED: December 30, 2004

Page 8

Please charge or credit any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,



Robert D. Schaffer  
Attorney/Agent for Applicant(s)  
Registration No. 33,775

Dated: November 19, 2008

**Pearl Cohen Zedek Latzer, LLP**  
1500 Broadway, 12th Floor  
New York, New York 10036  
Tel: (646) 878-0800  
Fax: (646) 878-0801